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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/195,270	11/18/1998	KATSUHIRO OCHIAI	P/2054-95	4140
7590	06/29/2004		EXAMINER	
STEVEN I WEISBURD ESQ DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS - 41ST FLOOR NEW YORK, NY 10036			SALCE, JASON P	
			ART UNIT	PAPER NUMBER
			2611	20
DATE MAILED: 06/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/195,270	OCHIAI ET AL.	
	Examiner	Art Unit	
	Jason P Salce	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2,7-14 and 16 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) 2,7-10 and 16 is/are allowed.
- 6) Claim(s) 11-14 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: ____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: ____ . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed 4/16/04 have been fully considered but they are not persuasive.

Applicant has added the limitation "said first and second broadcast stream being independent of each other" to independent claim 11, and argues that Majeti fails to discloses two physically separate broadcast streams. The examiner disagrees that this added limitation reads over the prior art. The arguments made by the applicant are inconsistent. Applicant argues that the first and second broadcast streams are physically independent, but adds the limitation "first and second broadcast stream being independent of each other". The limitation independent is broader than the limitation physically. Regardless, Majeti teaches both instances of independent broadcast streams and physically separate broadcast streams.

In regards to the broadcast streams being independent of one another, see Column 4, Lines 20-24 where Majeti discloses that the head-end receives signals and multiplexes them into television bandwidth signals (separate channels) into one complete 6 Mhz channel, where one user is served by a 6 Mhz channel. Majeti further discloses at Column 4, Lines 32-36 for splitting the 6 Mhz channel and extracting the television and other data (first and second broadcast stream), therefore, these broadcast streams are independent in that they are contained in there own channel, within the 6 Mhz channel.

Furthermore, in regards to the applicant's actual argument of the broadcast streams being physically separate, Majeti discloses a PSTN and a cable network, which sends two broadcast streams to the user over physically separate routes, therefore the broadcast streams are physically separate (see Column 8, Lines 39-67 and Column 9, Lines 1-35).

Therefore, Majeti still reads on the added limitations and the rejection stands and is repeated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majeti et al. (U.S. Patent No. 5,534,913) in view of Cragun et al. (U.S. Patent No. 5,859,662).

Referring to claim 11, Majeti discloses a broadcast resource receiver (see element 62 in Figure 1) receiving at least a first broadcast stream (see Column 4, Lines 27-32 for receiving a television signal), said broadcast resource receiver being responsive to a unified notation (see Column 4, Lines 20-24 for a unified notation (transmission format from the headend)), said unified notation identifying at least said first broadcast stream (the television programs) and a second broadcast stream (see Column 4, Lines 11-17 for adding digital information (second broadcast stream) to the

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television programs sent from the head-ends 30A-30N), said unified notation being independent from a capture route, a capture time, and an inherent name (see again Column 4, Lines 20-24 to show that the first and second broadcast streams are simply multiplexed into 6Mhz channels that can be interpreted at the customer premise, which inherently contains no capture route, capture time or inherent name data), said first and second broadcast stream being independent of each other (see arguments above).

Majeti also discloses a communication resource receiver (personal computer 74 in Figure 1) receiving at least said second broadcast stream (see Column 4, Lines 32-36), said broadcast resource receiver being response to said unified notation (see arguments presented above).

Majeti also discloses a reception route selection apparatus (see splitter 58 in Figure 1) being responsive to said unified notation, said reception route selection apparatus selecting said broadcast resource receiver or communication resource receiver for receiving one of said broadcast streams (see Column 5, Lines 30-40 for splitting the signal, which has a unified notation (see Column 4, Lines 20-24) and sending it to the proper apparatus) based on at least a first broadcast time corresponding to said first and second broadcast streams (see Column 10, Lines 41-52 for specifying a time to transmit broadcast streams according to available bandwidth).

Majeti also discloses route selection for capturing said broadcast streams (see again arguments regarding the splitter for capturing the proper stream and routing the stream to either the set top box 62 or the personal computer 74), said route selection

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being uniquely decided dependent on a broadcast time of said broadcast streams (see arguments above, regarding broadcasting a stream at a specified time).

Majeti fails to disclose an arbitrary portion of one of said broadcast streams is cut and then transferred onto a communication route. Cragun discloses capturing portions of a broadcast for future viewing (see Column 10, Lines 47-55, Column 11, Lines 37-62 and Column 12, Lines 20-28). At the time the invention was made, it would have been obvious to modify the customer premise equipment, as taught by Majeti, to utilize the capturing equipment based on an incoming broadcast stream, as taught by Cragun, for the purpose of allowing the viewer to selectively control what is viewed (see Column 1, Lines 61-62 of Cragun).

Claim 12 corresponds to claim 11, where Majeti discloses that one of the broadcast streams is a TV broadcast (see Column 4, Lines 20-22).

Claim 13 corresponds to claim 11, where Majeti discloses that one of the broadcast streams is a radio broadcast (see Column 2, Lines 63-65 for transmitting the cable television signals over an RF communication means, therefore this transmission is a radio broadcast).

Claim 14 corresponds to claim 11, where Majeti discloses that one of the broadcast streams is an Internet broadcast (see Column 2, Lines 20-26 for a suggestion of providing computer users with Internet access). Majeti does not specifically disclose using the personal computer 74 for Internet access. The examiner takes Official Notice that it is well known for such a system of Majeti to provide a user with Internet access. At the time the invention was made, it would have been obvious to a person of ordinary

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skill in the art, to modify the system of Majeti and Cragun, by providing the personal computer with Internet access, for the purpose of allowing the user to view information via the WWW or check his/her email.

Allowable Subject Matter

3. Claims 2, 7-10 and 16 are allowed, as discussed in the previous Office Action.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 23, 2004



VIVEK SRIVASTAVA
PRIMARY EXAMINER